Remarks

Reconsideration of this Application is respectfully requested.

Claims 1-7, 9, 16-24, and 46-67 are pending in the application, with claims 1, 16, 46, 53, and 65 being the independent claims. Claims 1, 4, 16, 46, 53, and 65 are sought to be amended. These changes are believed to introduce no new matter and their entry is respectfully requested. New claims 66 and 67 are sought to be added.

Based on the above amendments and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Interview

Applicants thank the Examiner for the courtesies extended to Applicants' representative Omar Amin, Reg. No. 60,885, during a telephonic interview on April 9, 2009.

Priority

The Examiner has noted that the present application 09/864,293 is a Continuation-In-Part (CIP) of Applications 09/559,964 and 09/393,390. The Examiner has alleged that this Application, 09/864,293, does not benefit from an earlier filing date due to inadequate support. Applicants elect not to substantively respond to the Examiner's contentions at this time, but reserve the right to do so in the future.

Rejections under 35 U.S.C. § 112, First Paragraph

Claims 59-64 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Specifically, the Examiner alleges that the term "synchronization token" is not found in the Specification.

Applicants assert that the instant application does enable claims 59-64. See, for example, U.S. Patent No. 6,779,042 ("the '042 Patent"), which is incorporated by reference into the instant application and specifically referenced in paragraph 0047 of the Specification, where a sync operation is described. FIGS. 1G, 1H1, and 1H2 along with Col. 17, line 6 - Col. 22, line 48 of the '042 patent describe a synchronization token. Because the instant application enables claims 59-64, Applicants respectfully request that the rejection of claims 59-64 under 35 U.S.C. § 112, first paragraph, be reconsidered and withdrawn.

Claims 59-64 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out the subject matter which Applicants regard as the invention. Specifically, the Examiner asserts that because the term "synchronization token" is not defined, the claims are unclear. As described above, the '042 patent describes synchronization tokens. Applicants assert, then, that the term "synchronization token" is sufficiently defined, and respectfully request that the rejection of claims 59-64 under 35 U.S.C. § 112, second paragraph, be reconsidered and withdrawn.

Rejections under 35 U.S.C. § 103

Claims 1, 2, 4, 6, 7, 9, 16, 17, 19, 21, 22, 24, and 59-64 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,516,341 to Shaw

et al. ("Shaw") in view of U.S. Patent No. 5,848,396 to Gerace ("Gerace"). Claims 3, 5, 18, and 20 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shaw in view of Gerace in view of U.S. Patent No. 5,794,210 to Goldhaber et al. ("Goldhaber"). Claim 50 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shaw in view of Gerace in view of U.S. Patent No. 6,332,127 to Bandera et al. ("Bandera") in view of Goldhaber. Claims 23, 46-54, and 65 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shaw in view of Gerace in view of Bandera. Claims 57 and 58 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shaw in view of Gerace in view of U.S. Patent No. 5,933,11 to Angles et al. ("Angles"). Applicants respectfully traverse the rejections.

Claim 1 recites features that distinguish over the applied references. For example, claim 1 recites "generating tracking data representative of a browsing activity of the user while using the device using a processor" and "storing the tracking data on the device." The applied references do not teach or suggest these features of claim 1.

The instant application supports the above-mentioned distinguishing feature of claim 1. For example, Col. 16, lines 50-67 and FIG. 1F1 of the '042 patent, which is incorporated by reference into the instant application, may provide support for these features of claim 1.

None of the applied references teaches or suggests these features of claim 1. On page 6 of the Office Action, the Examiner asserts that Col. 23, lines 25-32, Col. 19, lines 15-35, and FIGS. 5 and 6 of Shaw disclose "tracking browsing activity and sending that browsing activity information to the server." Col. 19, lines 15-35 and FIG. 5 of Shaw describe advertisement statistics that includes, for example, which advertisements are

shown to the user and an event log that includes, for example, when the user activates a client program and how long the program was used. Col. 23, lines 25-32 and FIG. 6 of Shaw describe the transmission of the advertisement statistics, the event log, and information about the user to the server. None of these sets of information, however, teach or suggest "data representative of a *browsing activity* of the user while using the device," as recited in claim 1. In particular, none of these sets of information include data regarding what the user has browsed, e.g., over the Internet. Thus, the cited portions of Shaw do not teach or suggest "generating tracking data representative of a browsing activity of the user while using the device using a processor," as recited in claim 1. Moreover, no other portion of Shaw provides the description missing from the portions cited by the Examiner.

On page 7 of the Office Action, the Examiner asserts that Col. 6, line 57 - Col. 7, line 24 and the Abstract of Gerace disclose "tracking activity for better targeting purposes" in of Gerace. Col. 6, line 57 - Col. 7, line 24 describes a user action history object 37e that stores each of the user's mouse clicks and a user viewing history object 37f that stores information regarding the screen views displayed to the user. Objects 37e and 37f are both a portion of program 31 that is "operated on and connected though a server 27 to the Internet..." See, Gerace, Col. 5, lines 41-43 and Col. 3, lines 57-62. The Abstract describes a similar storing process. Even assuming the data that objects 37e and 37f store discloses the generated tracking data recited in claim 1, which Applicants do not concede, Gerace still does not teach or suggest "storing the tracking data on the device," as recited in claim 1, because that data is stored at the server. Thus, Applicants assert that claim 1 is patentable over Gerace.

Moreover, Applicants assert that Goldhaber, Bandera, and Angles do not cure the deficiencies of Shaw and Gerace. Thus, Applicants assert that claim 1 and its dependent claims are patentable over the applied references. Furthermore, independent claims 16, 46, 53, and 65 recite similar distinguishing features as independent claim 1. Thus, claims 16, 46, 53, and 65 and their respective dependent claims are patentable over the applied references at least in view of the remarks above, and further in view of their own respective features.

Accordingly, Applicants respectfully request that the rejections of claims 1-7, 9, 16-24, and 46-67 be reconsidered and withdrawn.

New Claims 66 and 67

New claims 66 and 67, which depend from independent claim 1, are patentable over the applied references at least in view of their dependency to independent claim 1, and further in view of their own respective features. Accordingly, Applicants respectfully request that new claims 66 and 67 be passed to allowance.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,

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